UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/721,008 | 11/24/2003 | Gary Goodrich | 568-2 | 5644 |

7590 01/12/2007

Thomas M. Freiburger
PO BOX 1026
Tiburon, CA 94920

| EXAMINER | |
|---|---|
| FULTON, CHRISTOPHER W | |
| ART UNIT | PAPER NUMBER |
| 2859 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 01/12/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/721,008 | GOODRICH ET AL. | |
| | Examiner | Art Unit | |
| | Christopher W. Fulton | 2859 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: The status of parent application 10/338,764 cited on the first page of the application needs to be updated.

Appropriate correction is required.

### *Claim Objections*

2. Claims 5-7 and 10-14 are objected to because of the following informalities: Claims 5 and 10 are objected to for being unclear at lines 13+ and 19+ respectively since it doesn't seem that the device could work properly if the base side that has the window is placed against the wall because then the laser light could not exit the window. To advance prosecution the claims will be read as if an edge of the base side is against the wall. Claim 5 lines 16+ is objected to because it is unclear how the beam, which is self-leveling and claimed as such at lines 18+, is claimed "without self-leveling". To advance prosecution the claims will be read as if the housing is placed against the wall without leveling the housing with respect to the horizontal level plane. Appropriate correction is required.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d

2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-4 and 8 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 9, and 11 of U.S. Patent No. 6,502,319. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the application are broader then the patented claims by removing limitations of the patented claims and are covered by the patented claims.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 5, 6, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Marshall et al.

The device as claimed is disclosed by Marshall et al with a housing 11 having windows for the exit of fan-shaped beams with the fan-shaped beams being mounted on a self-leveling single axis pendulum to output level and plumb beams.

7. Claims 5, 8, 10, 12, 13, 15, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Raskin et al.

The device as claimed is disclosed by Raskin et al with a housing 11 having windows for the exit of fan-shaped beams with the fan-shaped beams being mounted on a self-leveling single axis pendulum to output level beams along with a stub finder to locate studs in walls.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall et al in view of Le.

The device as claimed is disclosed by Marshall et al as stated in the rejection recited above for claims 5, 6, and 10, but lacks the plumb beam extending above and below the device and the specific spacing of the beam from the housing. Le teaches extending a plumb line both above and below the intersection point to extend the line from the ceiling to the floor. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to project a plumb line below the device of Marshall et al as taught by Le to extend the plumb line to the ceiling as well as the to the ceiling. The specific positioning and size of items in a device are not patentably distinct features unless the positioning or size is critical to the invention and

provide an unexpected result. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the beam source relative to the housing in the combination of Marshall et al and Le at any desired location, such as the claimed 25mm-125mm, to space the beams from the housing.

10. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raskin et al in view of Marshall et al.

The device as claimed is disclosed by Raskin et al as stated in the rejection recited above for claims 5, 8, 10, 12, 13, 15, and 16, but lacks a plumb beam extending from the device and the specific spacing of the beam from the housing. Marshall et al teaches extending a plumb line from the device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to project a plumb line from the device of Raskin et al as taught by Marshall et al to extend the plumb line from the device. The specific positioning and size of items in a device are not patentably distinct features unless the positioning or size is critical to the invention and provide an unexpected result. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the beam source relative to the housing in the combination of Raskin et al and Marshall et al at any desired location, such as the claimed 25mm-125mm, to space the beams from the housing.

11. Claims 14, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raskin et al in view of Levine et al.

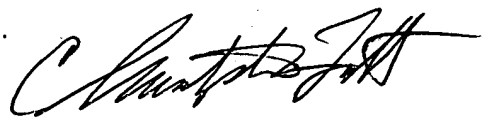
The device as claimed is disclosed by Raskin et al as stated in the rejection recited above for claims 5, 8, 10, 12, 13, 15, and 16, but lacks a bracket to removably attach a stud finder to a laser generator and level vials on the housing to indicate the orientation of

the housing relative to level and plumb. Levine et al teaches using a bracket to removably attach a stud finder to a laser generator so the devices can be used separately as well as together. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to separately connect the stud finder to the laser generator with a bracket in Raskin et al as taught by Levine et al so the items can be used separately as well as together. Levine et al also teaches using multiple level vials on the housing to determine the orientation of the housing relative to level and plumb. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add multiple level vials to the housing of Raskin et al as taught by Levine et al to determine the orientation of the housing relative to level and plumb.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher W. Fulton whose telephone number is (571) 272-2242. The examiner can normally be reached on M-Th 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Christopher W. Fulton
Primary Examiner
Art Unit 2859

CWF